

REMARKS

Reconsideration of the subject application in view of the foregoing amendment is respectfully requested.

By the present amendment, claim 9 has been amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

The Examiner rejected claims 1 through 7 under 35 U.S.C. § 103(a) as being unpatentable over Olvera et al., U.S. Patent No. 5,897,045 in view of Lin, U.S. Patent No. 6,779,697 (Lin). Claim 8 was rejected as claims 1-7 above and further in view of Caringella et al., U.S. Patent No. 6,761,299 (Caringella). It is respectfully submitted that claims 2-9 are patentable over the combination set forth in the Office Action.

Specifically, claim 9 recites a head piece which is arranged at the outlet opening (10) of the guide pipe with a possibility of a pivotal movement relative to the rest of the drive-in device and relative to the pipe arrangement. With the only head piece being rotated, all other device components, including the pipe

arrangement, remain stationary with respect to the device handle arrangement, which permits the device user to walk straight ahead while driving the fasteners in, even with the orientation of the profiled workpieces being changed.

Rotation or pivoting of the headpiece permits to orient the headpiece, together with the drive-in tool, to the workpiece profile. As explained in the specification (page 3, second paragraph), such a stand-up drive-in device substantially facilitates the work when long rows of fasteners should be placed one after another in profiled workpieces with alternating orientation of rows.

It is respectfully submitted that the present invention would not be obvious in view of the prior art, including Olvera and Lin. Olvera, as it is noted by the Examiner, does not disclose a rotatable head piece. Lin discloses a tool in which the magazine is connected to the tool barrel (head piece) for joint rotation therewith relative to the rest of the tool. The object of Lin is to insure rotation of the feed arrangement (magazine, corresponds to pipe arrangement) (column 1 lines 32-36). Lin uses barrel to provide for rotation of the pipe arrangement. Lin in effect teaches a way from rotating the barrel (the headpiece) relative to the feed arrangement.

Accordingly, if Olvera were to be modified in view of Lin, Olvera would have a head piece rotatable together with the pipe arrangement and not relative to the pipe arrangement, as recited in claim 1 of instant application.

Under MPEP, § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that neither the first nor the third criterium of obviousness has been met.

Because the combination of Olvera and Lin does not disclose or suggests all of the limitations of claim 9, it is respectfully submitted that the present invention, as defined by claim 1, is not rendered obvious by the combination of Olvera and Lin, assuming, *arguendo*, Olvera and Lin are combined.

However, it is respectfully submitted that *prima facie* case of obviousness has not been met.

The advisory Action asserts that “the case of *prima facie* obviousness has been satisfied and that there is sufficient motivation to combine the references of Olvera and Lin.”

The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record is any evidence, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrive at the claimed invention. *In re Jones* 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

According to M.P.E.P., a statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01 relying on *Ex Parte Levengood*, 28 U.S.P.Q.2d 130 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie case* of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or inference in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant

teachings.” Id. At 1301. It is noted that the existing case law rejects the “common knowledge” of one skilled in the art as a substitute for specific evidence that the prior art suggests the invalidating combination or references. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

No such evidence is present in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the *In re Fritch* holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Spinnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

It is respectfully submitted that obviousness of the present invention over the combination of Olvera and Lin can be gleaned only from a hindsight reconstruction.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in Uniroyal v. Redkin-Willey, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

Nothing in the prior art suggests the desirability of the combination set forth in the Office Action. The same Court further stated:

. . . it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention.”

In view of the above, it is respectfully submitted that the combination of Olvera and Lin does not make obvious the present invention, as defined in Claim 9, and the present invention, as defined by Claim 9 is patentable over said combination.

Claims 2-8 depend on claim 9 and are allowable as being dependent on an allowable subject matter.



CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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